

### REMARKS

This is in response to the Office Action mailed on July 9, 2004, and the references cited therewith.

Claims 69, 75-76, 94, 105, 108, 114, 115, 120, 122, 126 and 127 are amended, claims 132 and 135 are canceled, and no new claims are added; as a result, claims 69-112, 114-120, 122-127 and 129 are now pending in this application. Claims 76, 108, 115, 120 and 126 were not amended to overcome prior art rejections, but was amended to correct language in the claims.

#### Priority

The Office Action on page 2 refers to, "the provisional application upon which priority is claimed." Applicant respectfully submits that a claim for the benefit under 35 U.S.C. § 120 or 365(c) of PCT international application PCT/GB97/02850 has been made. Therefore, Applicant requests clarification as to what, if any, "provisional application" is being referred to by the Office Action.

In addition, the Office Action states, "the provisional application upon which priority is claimed fails to provide adequate support for claims 69-135 of this application." Applicant respectfully traverses this statement. Applicant submits that one of ordinary skill in the art would find support for claims 69-135 in the prior international application as filed. Therefore, Applicant submits that adequate support for claims 69-135 is provided in the application.

As stated above, Applicant has claimed the benefit under 35 U.S.C. § 120 or 365(c) of PCT international application PCT/GB97/02850. M.P.E.P. § 1895.01 states,

"To obtain benefit under 35 U.S.C. 120 and 365(c) of a prior international application designating the U.S., the continuing application must: (A) include a specific reference to the prior international application (either in the application data sheet (37 C.F.R. 1.76) or in the first sentence of the specification), (B) be copending with the prior international application, and (C) have at least one inventor in common with the prior international application."

The Office Action on page 2 states, "In order to perfect priority, the applicant also needs to submit a certified copy of the PCT." With regards to (A) above, M.P.E.P. § 1895.01 states, "a certified copy of the international application (and an English translation) of the international

application may be required by the examiner to perfect the claim for benefit under 35 U.S.C. § 120 and 365(c)." Applicant has attached a certified copy of International Patent Application No. PCT/GB97/02850.

The Office Action on page 2 states, "In order to be granted priority, the applicant must submit proof of codependency with an international application." With regards to (B) above, M.P.E.P. § 1895.01 states, "a U.S. national application is considered copending which a prior international application designating the U.S. if the international application was pending on the filing date of the U.S. National Application. Generally, except in cases where the international application has been withdrawn (either generally or as to the United States), an international application becomes abandoned as to the United States upon expiration of 30 months from the priority date." Applicant respectfully submits the PCT/GB97/02850 was pending on April 14, 2000, the date of filing of this application. The priority date for PCT/GB97/02850 is October 16, 1997, so the 30 month period for the application would extend until April 16, 2000. Therefore, this application was filed before the U.S. abandoned date. In addition, M.P.E.P. § 1895.01 states that in order to determine whether the application was withdrawn, an examiner may "require applicant to certify that the international application was not withdrawn or considered to be withdrawn, either generally or as to the United States, prior to the filing date of the national application claiming benefit under 35 U.S.C. 120 and 365(c) to such international application." Further, "proof may be in the form of copy of the "Notification of Receipt of Demand by Competent International Preliminary Examining Authority (Form PCT/IPEA/402) showing the demand was received prior to the expiration of 19 months from the priority date, and a copy of the "Notification Concerning Elected Offices Notified of Their Election (Form PCT/IB/332) showing the election of the United States." Applicant has attached a copy of Notification of Receipt of Demand by Competent International Preliminary Examining Authority (Form PCT/IPEA/402) for PCT/GB97/02850 showing the demand was received prior to the expiration of 19 months from the priority date. Applicant has also attached a copy of the "Information Concerning Elected Offices Notified of Their Election" (Form PCT/IB/332) for PCT/GB97/02850 showing the election of the United States.

With regards to (C) above, Applicant respectfully submits that this application has "at least one inventor in common with the prior international application."

Therefore, Applicant respectfully submits that a proper claim to obtain the benefit of a filing date of a prior international application have been met under M.P.E.P. § 1895.01. Hence, Applicant requests acknowledgement that this application's claim to the benefit under 35 U.S.C. § 120 or 365(c) of PCT international application PCT/GB97/02850 has been perfected and granted.

§102 Rejection of the Claims

Claims 69-71, 75-78, 80-88, 91, and 92 were rejected under 35 U.S.C. § 102(e) as being anticipated by Farese et al. (U.S. 4,996,685).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action has failed to make out a prima facie case of anticipation in that Farese does not teach each and every element of the claims as arranged in the claims.

With regards to claim 69, as amended the claim recites, "independent communications between said communication apparatus and each of said remote configuration system and said at least one service system." (emphasis added) In contrast, Farese at column 7, lines 35-38 discloses, "a communication processor called a 'broker' is connected between the host computer and the ISDN network. The broker passes communications between the host computer and the ISDN network." Since the communication processor can not communicate independently with the host computer, Applicant respectfully submits that there is no teaching or suggestion in Farese of "independent communications between said communication apparatus and each of said remote configuration system and said at least one service system" as recited in claim 69.

In addition, claim 69 as amended recites, "said initial configuration data not enabling said communication apparatus to communicate with said at least one service system." In contrast, Farese simply teaches a modification of a communication between a host computer and a remote user via a switch. Applicant respectfully submits that Farese fails to teach or suggest "initial configuration data," and further, Farese fails to teach or suggest "said initial configuration data not enabling said communication apparatus to communicate with said at least one service system" as recited in claim 69. Therefore, with respect to claim 69, Farese fails to recite each of the elements of claim 69.

With regards to claims 70-71, Applicant respectfully submits that as these claims are dependent on claim 69 the features of these claims in combination with claim 69 are neither taught or suggested by Farese.

With regards to claim 75, as amended the claim recites, "said second I/O to independently communicate with said remote configuration system and said at least one service system." (emphasis added) For reasons analogous to those stated above with regards to claim 69, Applicant respectfully submits that there is no teaching or suggestion in Farese of "said second I/O to independently communicate with said remote configuration system and said at least one service system" as recited in claim 75.

In addition, claims 75 as amended recites, "said initial configuration data not enabling said processor to control said second I/O to connect to said at least one service system." For reasons analogous to those stated above with regards to claim 69, Applicant respectfully submits that Farese fails to teach or suggest "initial configuration data," and further, Farese fails to teach or suggest "said initial configuration data not enabling said processor to control said second I/O to connect to said at least one service system" as recited in claim 75. Therefore, with respect to claim 75, Farese fails to recite each of the elements of claim 75.

With regards to claims 76-78, 80-88 and 91-92, Applicant respectfully submits that as these claims are dependent on claim 75 the features of these claims in combination with claim 75 are neither taught or suggested by Farese.

For the reasons stated above, Applicant respectfully requests withdrawal of the § 102 rejection and reconsideration of the allowance of claims 69-71, 75-78, 80-88, 91 and 92.

§103 Rejection of the Claims

Claims 72-74 and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91 and 92 above, and further in view of Ashton et al. (U.S. 6,181,679). Applicant does not admit that Ashton is prior art and reserves the right to "swear behind" Ashton as provided for under 37 C.F.R. § 1.131.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* In an attempt to meet this requirement, the Office Action on page 4 states, "Ashton is used as a more powerful monitoring system," and further "[t]his is something that Farese clearly could use," and further, "at the time the invention was made, one of ordinary skill in the art would have used an Ashton monitoring system in Farese in or to make Farese more management friendly (col. 2, lines 14-33)." Applicant submits that being able to "use" something does not provide the required objective teaching that would lead an individual to combine the relevant teaching of the references. In addition, the phrase "management friendly" is not used in the cited reference, and Applicant respectfully submits that the phrase is ambiguous. There is no disclosure in either the cited reference or in the Office Action as to what constitutes a "management friendly" monitoring system. Therefore, Applicant respectfully submits that the phrase "management friendly" fails to provide the required objective teaching that would lead an individual to combine the relevant teaching of the references. Thus, the Office Action fails to show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. Therefore, the Office Action has failed to state a *prima facie* case of obviousness with regards to claim 72-74 and 90 under 35 U.S.C. §103(a).

Applicant respectfully submits that the Office Action has failed to make a *prima facie* case of obviousness in that even if combined, the cited references fail to teach or suggest all of the elements of Applicant's claimed invention. The reference or references when combined must teach or suggest all the claim elements.

Claims 72-74 are dependent on claim 69, and include all the elements of claim 69. Claim

90 is dependent on claim 75, and includes all the elements of claim 75. For reasons analogous to those stated above with regards to claims 69 and 75, Applicant respectfully submits that neither Farese or Ashton, either alone or in combination, recite independent communication as recited in both claims 69 and 75. In addition, Applicant respectfully submits that neither Farese or Ashton, either alone or in combination, recite "initial configuration data," nor do either recite "initial configuration data not enabling" as recited in both claims 69 and 75. Therefore, the references fail to teach or suggest all the elements of claims 72-74 and 90.

For the reasons stated above, Applicant respectfully requests withdrawal of the § 103 rejection and reconsideration of the allowance of claims 72-74 and 90.

Claims 79, 89 and 93 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farese as applied to claims 69-71, 75-78, 80-88, 91 and 92 above, and further in view of Bhatia et al. (U.S. 6,118,768). Applicant does not admit that Bhatia is prior art and reserves the right to "swear behind" Bhatia as provided for under 37 C.F.R. § 1.131.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). In an attempt to meet these requirements, the Office Action on page 9 states, "one of ordinary skill would have connected a line to Farese in order to attach telephone equipment" and "one of ordinary skill in the art would have used a web server as a means of processing (col. 5, lines 1-10) as this was a standard method of I/O communication." Applicant submits that this is hindsight based on the disclosure of the present invention, and therefore is improper grounds for combining the references of Farese and Bhatia. Therefore, the Office Action has failed to state a *prima facie* case of obviousness with regards to claim 79, 89, and 93 under 35 U.S.C. §103(a).

Applicant respectfully submits that the Office Action has failed to make a *prima facie* case of obviousness in that even if combined, the cited references fail to teach or suggest all of the elements of Applicant's claimed invention. The reference or references when combined must teach or suggest all the claim elements.

Claims 79, 89 and 93 are dependent on claim 75, and include all the elements of claim 75. For reasons analogous to those stated above with regards to claim 75, Applicant respectfully submits that neither Farese or Bhatia, either alone or in combination, recite independent communication as recited in claim 75. In addition, Applicant respectfully submits that neither Farese or Bhatia, either alone or in combination, recite, "initial configuration data," nor do either recite "initial configuration data not enabling" as recited in claim 75. Therefore, the references fail to teach or suggest all the elements of claims 79, 89 and 93.

For the reasons stated above, Applicant respectfully requests withdrawal of the § 103 rejection and reconsideration of the allowance of claims 79, 89 and 93.

Claims 94-112, 114-120, 122-127, 129, 132 and 135 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farese, Ashton, and Bhatia.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

The Office Action repeatedly states on pages 9 and 10 that "the prior art teaches that a system implementation is functionally equivalent to the underlying method." Applicant respectfully disagrees with this statement. Applicant respectfully submits that claims 94-112, 114-120, 122-127, and 129 are patentably distinct over claim 69-93. In addition, in some instances claims 94-112, 114-120, 122-127, and 129 recite elements not found in claims 69-93.

For example, claim 105 as amended recites "a third I/O," claims 114 and 122 as amended recite "configuration data storage for storing configuration data specific for said service," and claim 127 as amended recites "processing information in accordance with stored configuration data specific for said service." Applicant respectfully submits that these elements do not appear in claims 69-93, and therefore the statement that certain claims of claims 94-112, 114-120, 122-127 and 129 are the "functional equivalent" of certain claims of claims 69-93 is incorrect. Therefore, Applicant respectfully submits that with regards to claims 94-112, 114-120, 122-127 and 129, the Office Action has failed to state a grounds for combining the cited references, and thus has failed to state a prima facie case of obviousness with regards to these claims.

Applicant respectfully submits that the Office Action has failed to make a prima facie case of obviousness in that even if combined, the cited references fail to teach or suggest all of the elements of Applicant's claimed invention. The reference or references when combined must teach or suggest all the claim elements.

With regards to claim 94, the claim as amended recites, "said I/O to independently communicate with said remote configuration system and said at least one service system." In addition, claim 94 as amended recites, "said initial configuration data not enabling said processor to control said I/O to connect to said at least one service system." For reasons analogous to those stated above with regards to claims 69 and 75, Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, recite independent communication as recited in claim 94. In addition, Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, recite, "initial configuration data," nor do the cited references recite "initial configuration data not enabling" as recited in claim 94. Therefore, the references fail to teach or suggest all the elements of claim 94.

With regards to claims 95-104, Applicant respectfully points out that they are dependent on claim 94 and that in combination with 94, none of the prior art references disclose or teach the features of claims 95-104.

With regards to claim 105, the claim as amended recites, "at least one service system being arranged to allow independent communications between said communication apparatus and each of said configuration system and said at least one service system." For reasons analogous to those stated above with regards to claims 69 and 75, Applicant respectfully submits



that neither Farese or Ashton or Bhatia, either alone or in combination, recite independent communication as recited in claim 105.

In addition, claim 105 as amended, recites "a third I/O for connection to said communication network, and for receiving said unique identification information from said communication apparatus to enable said communication apparatus to access at least one service system." (emphasis added) Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, recite, "a third I/O for connection to said communication network, and for receiving said unique identification information from said communication apparatus to enable said communication apparatus to access at least one service system" as recited in claim 105. Therefore, the references fail to teach or suggest all the elements of claim 105.

With regards to claims 106-112, Applicant respectfully points out that they are dependent on claim 105 and that in combination with 105, none of the prior art references disclose or teach the features of claims 106-112.

With regards to claim 114, the claim as amended recites, " a configuration data store for storing configuration data specific for said service" and further, " to process said information in accordance with said configuration data to generate summary information." Applicant submits that the claim as amended clarifies that configuration data, which is specific to a service, is stored and used for the processing of gathered information to generate summary information, which has been processed for each service in a service specific manner. In this way, the claimed invention enables service providers to utilize distributed processing of the gathered information in accordance with their requirements thus providing the benefits of reducing the amount of data that is required to be transmitted to them to obtain aggregate information for service users which is processed as they require. The Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, teach or suggest the local processing of gathered information in accordance with the service provider's requirements as recited in claim 114. Therefore, the references fail to teach or suggest all the elements of claim 114.

With regards to claims 115-120, Applicant respectfully points out that they are dependent on claim 114 and that in combination with 114, none of the prior art references disclose or teach the features of claims 115-120.

With regards to claim 122, the claim as amended recites, "a configuration data store for storing configuration data specific for said service" and further, "to process said information in accordance with said configuration data to generate summary information." For reasons analogous to those stated above with regards to claim 114, Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, teach or suggest the local processing of gathered information in accordance with the service provider's requirements as recited in claim 122. Therefore, the references fail to teach or suggest all the elements of claim 122.

With regards to claims 123-126, Applicant respectfully points out that they are dependent on claim 122 and that in combination with 122, none of the prior art references disclose or teach the features of claims 123-126.

With regards to claim 127, the claim as amended recites, "processing said information in accordance with stored configuration data specific for said service to generate summary information." For reasons analogous to those stated above with regards to claim 114, Applicant respectfully submits that neither Farese or Ashton or Bhatia, either alone or in combination, teach or suggest the local processing of gathered information in accordance with the service provider's requirements as recited in claim 127. Therefore, the references fail to teach or suggest all the elements of claim 127.

With regards to claims 129, Applicant respectfully points out that that it is dependent on claim 127 and that in combination with 127, none of the prior art references disclose or teach the features of claim 129.

For the reasons stated above, Applicant respectfully requests withdrawal of the § 103 rejection and reconsideration of the allowance of claims 94-112, 114-120, 122-127 and 129

With regards to claims 132 and 135, the claims have been canceled, so the rejection is moot.

*Pertinent Subject Matter*

The references cited as pertinent but not relied upon by the Office Action are not part of the rejections in the Office Action, so Applicant need not respond to the assertion of pertinence.

Applicant is expressly not admitting to this assertion of pertinence and reserves the right to address the assertion should it be included in a future rejection.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Oct. 12, 2004

By Ann M. McCrackin  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12th day of October, 2004.

PATRICIA A. HULTMAN

Name



Signature